REMARKS

Claims 39 through 64 were presented for examination in the present application and remain pending upon entry of the instant response.

Claims 39-42, 44-45, 49-50, 52, 54, 56, 58, 60, and 64 were rejected under 35 U.S.C. §103 over U.S. Patent No. 4,917,495 to Steenhoek (Steenhoek) in view of U.S. Patent No. 6,332,573 to Gu et al. (Gu) and U.S. Patent No. 4,838,697 to Kurandt (Kurandt). Claims 43 and 59 were rejected under 35 U.S.C. §103 over Steenhoek, Gu, and Kurandt in further view of U.S. Patent No. 5,268,749 to Weber et al. (Weber). Claims 46-48 and 61-63 were rejected under 35 U.S.C. §103 over Steenhoek, Gu, and Kurandt in further view of U.S. Patent No. 5,619,427 to Ohkubo (Ohkubo). Claim 51 was rejected under 35 U.S.C. §103 over Steenhoek, Gu, and Kurandt in further view of U.S. Patent No. 4,918,321 to Klenk et al. (Klenk). Claim 53 was rejected under 35 U.S.C. §103 over Steenhoek, Gu, and Kurandt in further view of U.S. Patent No. 5,596,412 to Lex (Lex). Claims 55 and 57 were rejected under 35 U.S.C. §103 over Steenhoek, Gu, and Kurandt in further view of the present application.

In sum, each obviousness rejection of the claims of the present application requires the combination of Steenhoek in view of Tang and Kurandt.

For an obviousness rejection to be proper, the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165

U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

It is submitted that the proposed combination of Steenhoek, Gu, and Kurandt lacks the required motivation to combine in the manner proposed by the Office Action.

Independent claim 39 recites, among other elements, a light diode aligned at a first predetermined angle to the surface. Similarly, independent claim 56 recites the step of aligning a light diode at a first predetermined angle to the surface.

However, Steenhoek discloses a portable colorimeter using conventional quartz halogen lamps for the determination of optical characteristics for colored surfaces in particular for surfaces, which contain metallic or pearlescent particles. Steenhoek attempts to resolve the problems associated with such conventional quartz halogen lamps using a complex active stabilization circuit for the achievement of a consistent color temperature. See col. 6, lines 1-66.

Gu is directed to data collectors, in particular to a barcode reader, that uses a light diode. Similarly, Kurandt is directed to a device for rapid color measurements, as used in polychromatic barcode readers.

It is respectfully submitted that one skilled in the art would not be motivated to combine the barcode readers as in Gu and Kurandt with the colorimeter system of Steenhoek having temperature stabilization to provide the light diode as recited by claims 39 and 56.

Moreover, it is respectfully submitted that a person skilled in the art would not look to the conventional quartz halogen lamps and temperature stabilization of Steenhoek as relevant to the solution obtained by the light diode of claims 39 and 56. In fact, it is submitted that the conventional quartz halogen lamps and temperature stabilization of Steenhoek teach away from the light diode recited by claim 39.

Accordingly, it is respectfully submitted that claims 39 and 56, as well as claims 40 through 55 and 57 through 64 that depend, therefrom are believed to be in condition for allowance. Reconsideration and withdrawal of the rejections to these claims are therefore respectfully requested.

In addition, Applicants respectfully traverse the rejection of dependent claims 46 through 48 and 61 through 63 over the proposed combination of Steenhoek, Gu, and Kurandt in further view of Ohkubo.

Claim 46 recites that "at least a portion of said emitted light comprises a light pattern". Similarly, claim 61 recites the step of "causing at least a portion of said emitted light to comprise a light pattern".

The Office Action asserts that the usage of a light pattern would be obvious in the view of Ohkubo. Applicants respectfully traverse this assertion.

Ohkubo is directed to a color conversion method and color conversion table generating apparatus. The latter could be used for an image output apparatus such as a color printer in order

to generate arbitrary colors out of three basic colors as, for instance, C (cyan), M (magenta) and Y (yellow). In the section cited by the Office Action, namely col. 6, lines 35 to 40, the grid pattern as depicted in Fig. 4 is referred to as being suitable for the representation of a CMY color space. However, Ohkubo further indicates that:

> "because an XYZ color space obtained from the CMY color space is distorted as shown in FIG. 9, it is difficult to determine color signals CMY corresponding to any optional stimulus signals XYZ. Therefore, stimulus signals XYZ arranged at regular intervals as indicated by the dotted lines in FIG. 9 are established in the XYZ color space, and color signals CMY corresponding to the stimulus signals XYZ are calculated according to the Newton's method thereby to determine the first reverse conversion table." See col. 6, lines 40-49.

Thus, it is submitted that the Ohkubo distorted CMY color space and associated conversion table does not disclose or suggest the light pattern recited by claims 46 and 61, respectively.

Therefore, claims 46 and 61, as well as claims 47 and 48 and claims 62 and 63 that depend respectively therefrom are believed to be in condition for allowance. Reconsideration and withdrawal of the rejection to claims 46 through 48 and 61 through 63 are respectfully requested.

Dependent claims 55 and 57 were rejected over Steenhoek, Gu, and Kurandt in further view of the present application at page 5, line 27. Applicants respectfully traverse this assertion.

Dependent claim 55 recites a measurement cycle of less than 0.2 seconds. Similarly, dependent claim 57 recites the step of

determining said at least one characteristic comprises a measurement cycle of less than 0.2 seconds.

The portion of the specification asserted against claims 55 and 57 is within the section entitled "Brief Summary of the Invention". Specifically, the portion of the present application cited by the Office Action is included in a list of advantages available from the present invention.

Applicants respectfully submit that the Office Action has used an improper standard in arriving at the rejection of the claims 55 and 57 under section 103, based on improper hindsight that fails to consider the totality of applicants' invention and to the totality of the cited references. In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole", not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil,* 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. Stated in another way, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch* 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

It is respectfully submitted that use of Applicants' disclosure of the advantages of their invention to render that invention obvious is improper. Moreover, it is submitted that the mere fact that light emitting diodes have the advantage to emit a stable light spectrum faster than conventional light

sources does not suggest the faster measurement frequencies recited by claims 55 and 57.

Accordingly, claims 55 and 57 are believed to be in condition for allowance. Reconsideration and withdrawal of the rejection to claims 55 and 57 are respectfully requested.

In view of the above, it is respectfully submitted that the present application is in condition for allowance. Such action is solicited.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

Respectfully submitted,

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